## REMARKS

Applicants respectfully request entry of the foregoing and reconsideration of the subject matter identified in caption, as amended, pursuant to and consistent with 37 C.F.R. §1.116 and in light of the remarks which follow.

Claims 1-11 are pending in the application.

By the above amendments, Claim 1 is amended at lines 9-13 to read, in part, ". . . the group consisting of at least one functional unit of heterocyclic nature having one or more electron-donating atoms, at least one ethylenically unsaturated functional unit substituted by at least one electron-donating atom which enhances the basicity of the π system, and mixtures thereof. . .." Claim 1 is further amended at line 15 to read, in part, ". . . which is a borate of a onium of an element from groups 15 to 17. . . ." Claim 1 is further amended at line 18 to read, in part, ". . . onium cations of formula (I) . . . ." Claim 1 is further amended by providing a plus symbol in the formula in line 21. Claim 7 is amended at line 7, by replacing "and/or from" with - - and - -. Finally, Claim 8 is amended by replacing B.p. with - - B.P.- -.

Applicants thank the Examiner for acknowledging that the Abstract of the Disclosure submitted on December 17, 2003, is accepted.

Turning now to the Official Action, Claims 1-11 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite. For at least the reasons that follow, withdrawal of the rejection is in order.

With respect to the rejection of Claim 1 for using improper Markush Group language at lines 9-13, Applicants have amended Claim 1 to obviate the rejection. In particular, Applicants has amended Claim 1 at lines 9-13 to read ". . . the group consisting of at least one functional unit of heterocyclic nature having one or more

electron-donating atoms, at least one ethylenically unsaturated functional unit substituted by at least one electron-donating atom which enhances the basicity of the π system, and mixtures thereof. . .."

With respect to the rejection of Claim 1 for use of the language formed by a "borate of an onium" at lines 15-17, Applicants have amended Claim 1 at line 15 to read, ". . . which is a borate of an onium of an element from groups 15 to 17. . . ."

With respect to the rejection of Claim 1 for failing to provide antecedent basis for "the cationic entity of said borate" Applicants submit that it appears that Claim 1 was previously amended in the Amendment filed on December 15, 2003, to address this issue. Thus, it is believed that no further response or amendment is needed to obviate the rejection.

With respect to the rejection of Claim 1 for use of the word "onium salts" in line 20, Applicants have amended Claim 1 at line 20 to obviate the rejection. In particular, Applicants have replaced the word "salts" with the word - - cations - -.

With respect to the rejection of Claim 1 for failing to provide a positive charge on the onium cation of formula (I), Applicants have amended the claim to obviate the rejection. Specifically, Applicants have added a plus symbol after the formula.

With respect to the rejection of Claim 1 for use of the term "nonorganosilicon" in the definition of (C), Applicants submit that no amendment is needed to obviate the rejection. That is, in addition to the disclosure at pages 35-36, which includes compounds such as vinyl ether, epoxies and oxetane compounds, Applicants believe that the disclosure at page 28 is sufficiently broad to support Applicants' use of "nonorganosilicon."

With respect to the rejection of Claim 4, for use of the term "oxethane" Applicants have amended Claim 4 to obviate the rejection. In particular, Applicants have replaced "oxethane" with - -oxetane- -, as proposed by the Examiner.

With respect to the rejection of Claim 7 for use of the word "and/or from", Applicants have amended Claim 7 to obviate the rejection. Specifically, Applicants have replaced "and/or from" with - -and- -.

Finally, with respect to the rejection of Claim 8 for use of the term "B.p.", Applicants have amended Claim 8 to obviate the rejection. In particular, Applicants have replaced "B.p." with - -B.P.- -.

For at least the above reasons, Applicants respectfully request reconsideration and withdrawal of the §112, second paragraph, rejections.

Claims 1-11 stand rejection under 35 U.S.C. §103(a) as being unpatentable over FR 2757870 (FR '870) in view of EP 0522703 (EP '703). For at least the reasons that follow, withdrawal of the rejection is in order.

Claim 1, as amended above, recites a process for carrying out impregnation and/or for preparing a coating which gives release and is leaktight employed at the *engine block/cylinder* head interface of engines and applied to sheet gaskets, comprising:

1 employing a silicone composition

comprising:

A 100 parts by weight of at least one polyorganosiloxane (POS) crosslinkable by the cationic and/or radical route and via crosslinking functional groups (CFGs), these CFGs being identical to or different from one another and being selected from the group consisting of at

least one functional unit of heterocyclic nature having one or more electron-donating atoms, at least one ethylenically unsaturated functional unit that is substituted by at least one electron-donating atom which enhances the basicity of the π system, and mixtures thereof;

B from 0.01 to 10 parts by weight of at least one initiator salt (PI) which is a borate of an onium of an element from groups 15 to 17 of the Periodic Classification or of an organometallic complex of an element from groups 4 to 10 of the Periodic Classification,

a *cationic entity* of said borate being selected from the group consisting of:

(1) onium cations of formula (I):

$$((R^1)_n\text{-}A\text{-}(R^2)_m)^+ \qquad (I)$$

in which formula:

A represents an element from groups 15 to 17;

$R^1$ represents a $C_6$-$C_{20}$ carbocyclic or heterocyclic aryl radical;

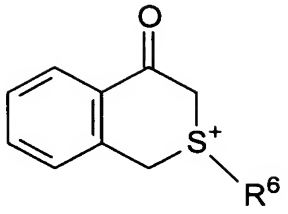
$R^2$ represents $R^1$ or a linear or branched $C_1$-$C_{30}$ alkyl or alkenyl radical;

said $R^1$ and $R^2$ radicals optionally being substituted by a $C_1$-$C_{25}$ alkoxy, $C_1$-$C_{25}$ alkyl, nitro, chloro, bromo, cyano, carboxy, ester or mercapto group,

n is an integer ranging from 1 to v + 1, v being the valency of the element A,

m is an integer ranging from 0 to v - 1, with n + m = v + 1

(2) the oxoisothiochromanium salts having the formula:

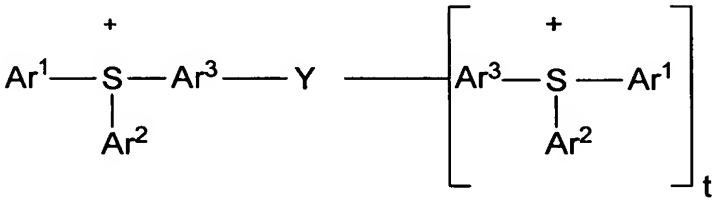


(II)

where the $R^6$ radical represents a linear or branched $C_1$-$C_{20}$ alkyl radical;

(3) sulfonium salts where the cationic entity comprises at least one of:

3.1. a polysulfonium species of formula III.1



(III.1)

in which:

the $Ar^1$ symbols, which can be identical to or different from one another, each represent a monovalent phenyl or naphthyl radical optionally substituted with one or more radicals selected from the group consisting of: a linear or branched $C_1$-$C_{12}$ alkyl radical, a linear or branched $C_1$-$C_{12}$ alkoxy radical, a halogen atom, an -OH group, a -COOH group, a -COO-alkyl ester group, where the alkyl part is a linear or branched $C_1$-$C_{12}$ residue, and a group of formula $-Y^4\ Ar^2$ , where the $Y^4$ and $Ar^2$ symbols have the meanings given immediately below,

the $Ar^2$ symbols, which can be identical to or different from one another or $Ar^1$ each represent a monovalent phenyl or naphthyl radical

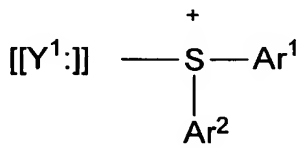
optionally substituted with one or more radicals selected from the group consisting of: a linear or branched $C_1$-$C_{12}$ alkyl radical, a linear or branched $C_1$-$C_{12}$ alkoxy radical, a halogen atom, an -OH group, a -COOH group and a -COO-alkyl ester group, where the alkyl part is a linear or branched $C_1$-$C_{12}$ residue,

the $Ar^3$ symbols, which can be identical to or different from one another, each represent a divalent phenylene or naphthylene radical optionally substituted with one or more radicals chosen from: a linear or branched $C_1$-$C_{12}$ alkyl radical, a linear or branched $C_1$-$C_{12}$ alkoxy radical, a halogen atom, an -OH group, a -COOH group or a -COO-alkyl ester group, where the alkyl part is a linear or branched $C_1$-$C_{12}$ residue,

t is an integer equal to 0 or 1,

with the proviso that:

when t = 0, the Y symbol is then a $Y^1$ monovalent radical representing the group of formula $Y^1$:

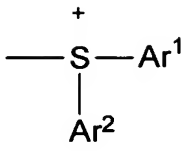


where the $Ar^1$ and $Ar^2$ symbols have the meanings given above,

when t = 1:

on the one hand, the Y symbol is then a divalent radical having the following meanings $Y^2$ to $Y^4$:

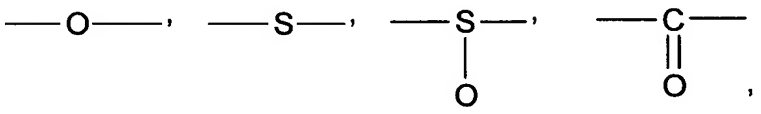
$Y^2$: a group of formula:



where the $Ar^2$ symbol has the meanings given above,

$Y^3$: a single valency bond,

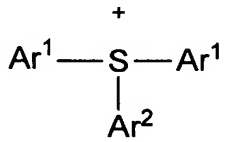
$Y^4$: a divalent residue selected from the group consisting of:



a linear or branched $C_1$-$C_{12}$ alkylene residue and a residue of formula $-Si(CH_3)_2O-$,

on the other hand, solely in the case where the Y symbol represents $Y^3$ or $Y^4$, the $Ar^1$ and $Ar^2$ (terminal) radicals have, in addition to the meanings given above, are optionally connected to one another via the Y', residue comprising $Y'^1$, a single valency bond, or in $Y'^2$ , a divalent residue selected from the group of residues recited in the definition of $Y^4$, which is inserted between the carbon atoms, facing each other, situated on each aromatic ring in the ortho position with respect to the carbon atom directly bonded to the $S^+$ cation; and

3.2. a monosulfonium species having a single $S^+$ cationic center per mole of cation and comprising, in the majority of cases, in species of formula:



(III.2)

in which $Ar^1$ and $Ar^2$ have the meanings given above with respect to the formula (III.1), including the possibility of connecting directly between them only one of the $Ar^1$ radicals to $Ar^2$ according to the way indicated above with respect to the definition of the additional condition in force when t=I in the formula (II) involving the Y' residue;

(4) organometallic salts of formula (IV):

$$(L^1L^2L^3M)^{q+} \qquad (IV)$$

in which formula:

M represents a metal from group 4 to 10,

$L^1$ represents 1 ligand bonded to the metal M via π electrons, which ligand is selected from the group consisting of $\eta^3$-alkyl, $\eta^5$-cyclopendadienyl, $\eta^7$-cyclo- heptatrienyl ligands and $\eta^6$ -aromatic compounds selected from the group consisting of optionally substituted $\eta^6$-benzene ligands and compounds having from 2 to 4 condensed rings, each ring being capable of contributing to the valency layer of the metal M via 3 to 8 π electrons,

$L^2$ represents a ligand bonded to the metal M via π electrons, which ligand is selected from the group consisting of $\eta^7$- cycloheptatrienyl

ligands and $\eta^6$ - aromatic compounds selected from the group consisting of optionally substitute $\eta^6$-benzene ligands and compounds having from 2 to 4 condensed rings, each ring being capable of contributing to the valency layer of the metal M via 6 or 7 π electrons, $L^3$ represents from 0 to 3 identical or different ligands bonded to the metal M via σ electrons, which ligand(s) is (are) CO or $NO_2^+$; the total electronic charge q of the complex to which $L^1$, $L^2$ and $L^3$ and the ionic charge of the metal M contribute being positive and equal to 1 or 2;

an *anionic entity* borate having the formula:

$$[BX_aR_b]^-$$

in which formula:

a and b are integers ranging from 0 to 3 for a and from 1 to 4 for b, with a+ b = 4,

the X symbols represent:

a halogen atom with a = 0 to 3,

an OH functional group with a = 0 to 2,

the R symbols are identical or different and represent:

a phenyl radical substituted by at least one electron-withdrawing group and/or by at least 2 halogen atoms, this being when the cationic entity is an onium of an element from groups 15 to 17,

a phenyl radical substituted by at least one electron-withdrawing element or group, this being when the cationic entity is an organometallic complex of an element from groups 4 to 10,

an aryl radical comprising at least two aromatic nuclei, which is optionally substituted by at least one electron-withdrawing element or group, whatever the cationic entity;

C 1 to 50 parts by weight of at least one reactive diluent selected from the group consisting of a nonorganosilicon, an organosilicon and an organic compound comprising, in its structure, at least one CFG as defined above and optionally at least one secondary functional group (SFG) other than a CFG but capable of reacting chemically with a CFG;

D 0 to 10 parts by weight of at least one pigment;

E 0 to 100 parts by weight of a filler of inorganic nature;

F 0 to 10 parts by weight of at least one photosensitizer;

G 0 to $10^{-2}$ part by weight of a stabilizer comprising at least one stabilizing amine agent,

H 0 to 5 parts by weight of an adhesion promoter;

2 applying this composition to a support ,and

3 crosslinking the applied composition by photochemical and/or thermal activation and/or under an electron beam. (Emphasis added.)

The Official Action takes the position that FR '870 discloses a cylinder-head gasket coating method that includes employing a silicone composition containing a polyorganosiloxane and an initiator identical to those set forth in Claim 1. In addition, the Official Action admits that FR '870 does not teach a reactive diluent corresponding to component (C) used in the instantly claimed method. However, the Official Action asserts that EP '703 teaches the use of a reactive diluent for

improving the performance of a bis(aryl) iodonium salt catalyst for epoxy silicone resins. The Official Action asserts that the resins and catalysts disclosed are analogous to those taught by FR '870. The Official Action further asserts that EP '703 teaches that reactive diluents provide improved miscibility of the catalyst and compositions having improved stability, improved hardening performance and improved anti-adherence. Finally, the Official Action further admits that EP '703 does not disclose using the composition for coating cylinder-head gaskets. Nevertheless, the Official Action concludes that it would have been obvious to one of ordinary skill in the art at the time of the invention to employ the reactive diluent of EP '703 and the analogous compositions of FR '870 for improving the performance of the catalyst, as taught by EP '703. Moreover, the Official Action asserts that one of ordinary skill in the art at the time of the invention would have been motivated by a reasonable expectation of providing improved miscibility of the catalyst and compositions having improved stability, improved hardening performance and improved anti-adherence. (See Official Action at pages 4-5).

FR '870 relates to the use of cross-linkable silicone compositions for fast, economical and simple impregnation and/or varnishing of flat joints (e.g., cylinder head gaskets). More precisely, FR '870 concerns the use of silicone compositions cross-linkable under UV radiation, by cationic process, and in the presence of specific photoinitiators selected among onium borates or organometallic complexes, of which the borate counter-anions contain at least a boron bound to at least a substituted phenyl (Me, F). The silicone liquid precursor is a polydimethylsilioxane (PDMS) substituted by cross-linking functional groups, by cationic process ($G_{fp}$) under UV of the epoxy or vinyloxy type. These $G_{fp}$ are present at the rate of 0.15 to

2.0 prkg of PDMS. FR '870 also relates to a method for impregnating/varnishing flat joints (e.g., cylinder head gaskets) using the specific PDMS composition plus photoinitiator of borate type as well as the treated joints and the compositions themselves. (See Abstract of PCT Application WO 98/29498 which corresponds to FR '870.)

EP '703 relates to diluents for iodonium photocatalysts. More particularly, EP '703 relates to diluents for iodonuim photocatalysts used in UV-curable epoxy silicone compositions. (See, EP '703 at lines 3-5.)

In establishing a *prima facie* case of obviousness under 35 U.S.C. §103, it is incumbent upon the Examiner to provide reasons why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from Applicant's disclosure. (See *Ex Parte* Nesbit, 25 USPQ2d 1817,1819 (BPA 1992); In re Oetiker, 24 USPQ2d 1443, 1446 (Fed. Cir. 1992).) The mere fact that the prior art can be modified does not make such a modification obvious unless the prior art suggests the desirability of the modification. (See In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984).) There must be some intrinsic basis in the prior art or some extrinsic factor that would prompt one of ordinary skill in the art to combine the teachings of the references; otherwise, the Patent Office's burden of establishing a *prima facie* case of obviousness has not been met. Moreover, the determination of whether some reason, suggestion or motivation existed for making the combination must be made from the viewpoint of the hypothetical person of ordinary skill in the

field of the invention. In re Oetiker, 24 USPQ2d 1443, 1446 (Fed. Cir. 1992); In re Raines, 28 USPQ2d 1630, 1631 (Fed. Cir. 1993).

In the present case, no such factors or motivations for combining FR '870 and EP '703 exist. In particular, FR '870 does not disclose or fairly suggest a process for carrying out impregnation and/or for preparing a coating which gives release and is leaktight at the engine block/cylinder head interface of engines and to sheet gaskets, comprising and employing a silicone composition comprising 1 to 50 parts by weight of at least one reactive diluent selected from a group consisting of a nonorganosilicon, an organosilicon and an organic compound comprising in its structure, at least one CFG and optionally at least one secondary functional group (SFG) other than a CFG but capable of reacting chemically with a CFG, as set forth in independent Claim 1.

In addition, the secondary reference, EP '703 is not even remotely related to providing a coating which gives release and is leaktight at the engine block/cylinder head interface of engines and applied to sheet gaskets. Instead, EP '703 relates to diluents for iodonium photocatalysts used in UV-curable epoxy silicone compositions.

In view of FR '870's failure to suggest modifying the disclosed silicone compositions to include 1 to 50 parts by weight of at least one reactive diluent selected from the group consisting of a nonorganosilicon, an organosilicon and an organic compound comprising in its structure, at least one CFG and optionally at least one secondary functional group other than a CFG but capable of reacting chemically with a CFG, and the failure of EP '703 to provide any suggestion whatsoever that one should, or even could, use the disclosed diluents for idonium

photocatalysts in a process for preparing a coating which gives release and is leaktight at the engine block/cylinder head interface of engines, Applicants submit that the Official Action has not demonstrated that one of ordinary skill in the art would have been motivated to combine the references to obtain the process of independent Claim 1.

That is, the Official Action has not shown any motivation why one of ordinary skill in the art would have looked to the varying teachings of the references, and combined those teachings to obtain the claimed process. Clearly, the motivation for doing so can only come from the teachings of the present specification, which teaches the desirability of the claimed silicon composition, including reactive diluent component (C), for preparing a coating to provide release and leaktight properties at the engine block/cylinder head interface of engines. However, the teaching, suggestion or motivation for combining the cited references, cannot come from the Applicants' invention itself. In re Oetiker, 977 F.2 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). That is, the motivation for combining the references cannot be a hindsight reconstruction of the claimed invention based on Applicants' own disclosure.

Such a hindsight reconstruction has clearly been made in the Official Action. The Official Action asserts that the claimed invention would have been obvious based on the hindsight selection of claimed elements. Such a combination is improper because the references, viewed by themselves and not in retrospect, must suggest the combination asserted by the Official Action. See In re Shaffer, 229 F.2d 476, 108 USPQ 326 (CCPA 1956); In re Stoll, 523 F.2 1392, 187 USPQ 481 (CCPA 1975). Here, the references do not provide any motivation for combining the different elements (i.e., a silicone composition and diluents for iodonium

photocatalysts) of the references to obtain the presently claimed process. The only motivation for combining the teachings of these references to arrive at the claimed process derives from the disclosure of the present application, which is clearly improper.

In addition, Applicants submit that the Official Action fails to establish that the prior art provides a reasonable expectation of success. In particular, MPEP §2143.02 states that a reasonable expectation of success is required to establish a *prima facie* case of obviousness. That is, beyond looking to the prior art to determine if it suggests doing what the inventor has done, one must also consider if the art provides the required expectation of succeeding in that endeavor. See In re Dow Chem. Co. v. American Cyanimide, 837 F.2 at 473, 5 USPQ2d at 1531 ("both the suggestion and the expectation of success must be founded in the prior art, not in Applicant's disclosure"). (Emphases added.)

In this case, however, the asserted combination of references provides neither a suggestion nor an expectation of success in doing what the inventors have done (i.e., preparing a coating which gives release and is leaktight at the engine block/ cylinder head interface of engines and applied to sheet gaskets comprising and employing a silicone composition comprising 1 to 50 parts by weight of at least one reactive diluent selected from the group specified in component (C) of Claim 1. Specifically, one would not have expected to obtain the claimed process by modifying the composition of FR '870 to include one component of a photocatalyst composition (i.e., a reactive diluent) for use in UV-curable epoxy silicone compositions, which are neither disclosed nor suggested for use in providing release and/or leaktightness at an engine block/cylinder head interface.

Furthermore, the Federal Circuit has stated that, evidence rising out of the so–called secondary considerations must always, when present, be considered in route to a determination of obviousness. Indeed, evidence of secondary considerations can often be the most probative and cogent evidence in the record. It can often establish that an invention appearing to have been obvious in light of the prior art was not. See Stratoflex Inc. v. Auroquip Corp., 218 USPQ 871, 879 (Fed. Cir. 1983); Joy Technologies v. Quigg, 14 USPQ2d 1432, 1444 (DDC 1990).

In the present case, there is certainly no appreciation in any of the cited references, alone or in combination, of the unexpected and surprising advantages obtained by the claimed process. In particular, Applicants submit that the cited references, even in combination, fail to disclose or suggest that one could obtain a process for carrying out impregnation and/or for preparing a coating which provides sufficient release and is leaktight at the engine block/cylinder head interface of engines, or a coating that exhibits surprisingly superior solvent and scratch resistance.

In view of the Official Action's indication that the experimental data and arguments concerning unexpected results provided in the Amendment filed on December 17, 2003, were not persuasive, Applicants have submitted the enclosed Declaration of Dr. Jean-Marc Frances.

In the enclosed Declaration, Applicants present comparative test data, which was obtained to demonstrate the unexpected and surprising properties of products made using the claimed process would not be obtained by conventional coating processes such as that described in FR '870. As explained in the Declaration, the comparative tests were conducted in accordance with Example 2, described at page

52 of the specification. Applicants submit, and the Declaration of Dr. Frances confirms that the test data obtained by these experiments shows that a 6.25-fold improvement in solvent resistance (i.e., MEK (methyl ethyl ketone)) was observed and a two-fold improvement in scratch resistance was observed in the products made using the process of the present invention as compared to the comparative product made without any of component (C).

In considering the comparative test data presented in the enclosed Declaration, Applicants note that an Affidavit or Declaration under 37 C.F.R. §1.132 need only compare the claimed subject matter with the closest prior art to be effective to rebut a *prima facie* case of obviousness. See In re Burckel, 592 F.2d 1175, 201 USPQ 67 (CCPA 1979). In addition, although evidence of unexpected results must compare the claimed invention with the closest prior art, Applicants are not required to compare the claimed invention with the asserted combination of references relied upon in a rejection, where the comparison would result in comparing "the results of the invention with the results of the invention." See In re Chapman, 357 F.d 418, 422, 148 USPQ 711, 714 (CCPA 1966). See also MPEP § 716.02(e).

Thus, even if the Official Action had established a *prima facie* a case of obviousness, Applicants submit that the unexpected results achieved by the claimed process, as demonstrated and attested to in the attached Declaration by Dr. Frances, would rebut such a showing. Accordingly, the rejection under 35 U.S.C. § 103(a) should be withdrawn for at least this additional reason.

Furthermore, Applicants submit that the asserted combination of references is improper because the references are non-analogous . In particular, as stated in In re Wood and Eversole, 202 U.S.P.Q. 171, 174 (CCPA 1979),

> The determination that a reference is from a non-analogous art is therefore two-fold. First, we decide if the reference is within the field of the inventors endeavor. If it is not, we proceed to determine whether the reference is reasonably pertinent to the particular problem with which the inventor was involved. (Emphasis added.)

In Ex parte Dussaud[1], 7 U.S.P.Q. 2d, 1818, 1819 (BPAI 1988), the Board of Patent Appeals and Interferences ("Board") warned against the overly broad definition of the problem with which the inventor was involved. In finding that a cited reference was not reasonably pertinent to the particular problem with which the inventor was involved, and thus did not qualify as analogous prior art, the Board stated:

> We also find that the Examiner's characterization of the problem in Paper No. 22, *i.e.*, "the laminating of continuous running sheets utilizing a hot melt adhesive", is broader than the particular problem with which Appellants were involved. Precise definition of the problem is important in determining whether a reference is from a non-analogous art. Defining the problem to narrowly may result in excluding consideration of relevant prior art. By the same token defining the problem too broadly, as done here, may result in considering prior art as "analogous" which is inconsistent with real world considerations. (Emphasis added).

[1] In Dussaud, the Board determined that a reference related to the field of carpet manufacture was not within the field of manufacturing disposable diapers according to the claimed invention. The Board also found that the carpet manufacturing reference was not reasonably pertinent to the particular problem with which the inventors were involved in manufacturing disposable diapers.

In Ex parte Murphy[2], 217, USPQ 479, 482 (BPAI 192), the Board found that references cited in a rejection under 35 U.S.C. §103 were not directed to the particular problem addressed by the inventor, and thus reached the same conclusion as in Dussaud, that the references were from non-analogous art.

Applicants submit that when the test for analogous art stated in In re Wood is applied, in light of the Board's holding in Dussaud and Murphy, to the "particular problem with which the inventor was involved" (emphasis added), it is clear that EP '703 is not directed to the particular problem with which the inventor was involved. In particular, the claims are directed to a process for carrying out impregnation and/or for preparing a coating which gives release and is leaktight employed at the engine block/cylinder head interface of engines and applied to sheet gaskets. Nowhere does EP '703 disclose or even suggest the possibility of addressing this problem.

Instead, EP '703 relates to diluents for idonium photocatalysts used in UV-curable epoxy silicone compositions. Nowhere does EP '703 suggest using the disclosed diluents in a process for preparing a coating which gives release and is leaktight at the engine block/cylinder head interface of engines. EP '703 is neither related to the cross-linkable silicone compositions of FR '870, nor reasonably pertinent to the particular problem of obtaining a process for carrying out

[2] In Murphy, the claimed invention was directed to an animal ear tag. The invention addressed the problem of providing a spike for puncturing a hole in a member that is comparable to the ear of an animal, while simultaneously installing a two-piece item on opposite sides of the punctured member. Cited references were directed to the insertion of a spike in an already-existing puncture of hole in a pneumatic tire, with the purpose of carrying a means to seal the puncture against an air leak.

impregnation and/or for preparing a coating which gives release and is leaktight at the engine block/cylinder head interface of engines and applied to sheet gaskets, as addressed by the claimed invention.

To assert that EP '703 is analogous art, would be to define the problem with which EP '703 is involved too broadly.

Accordingly, because EP '703 does not meet either of the two requirements set forth in the In re Wood test, it is respectfully submitted that EP '703 cannot qualify as analogous prior art. Accordingly, the rejection of claims 1-11 over the combination of FR '870 in view of EP '703 is improper for at least this additional reason.

Claims 1-11 stand rejected under the judicially-created doctrine of obviousness/double patenting over Claims 1-13 of U.S. Patent 6,423,378. Because the pending claims are still under consideration, Applicants again respectfully request that the Examiner hold this rejection in abeyance until there has been an indication of allowable subject matter. When an indication of allowable subject matter is made, Applicants will be able to determine if a response to the obviousness/double patenting rejection is warranted.

From the foregoing, Applicants earnestly solicit further and favorable action in the Notice of Allowance.

If there are any questions concerning this paper or the application in general, Applicants invite the Examiner to telephone the undersigned at the Examiner's earliest convenience.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

Date: April 23, 2003

By: 

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Attachment: Declaration of Dr. Jean-Marc Frances